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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,794	04/24/2001	Michael J. Jones	10010536-1	6803

7590 03/15/2006
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,794

Applicant(s)

JONES, MICHAEL J.

Examiner

HELEN SHIBRU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/01/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 12/22/2005, have been entered and made of record. In view of the applicant's amendment the objection of the title and claim 6 is hereby withdrawn. Claims 1-21 are pending.

Response to Arguments

2. Applicant's arguments filed on 12/22/2005 have been fully considered but they are not persuasive. See the new ground(s) of rejections set below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 13, 15-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Millevolte (EP-0855288A2).

Regarding claim 1, Millevolte discloses a personalized storage medium and packaging, comprising:

a computer writeable storage medium (CD-ROM or floppy disk) including at least one stored user specified computer file (see col. 1 lines 22-26) and having a predetermined physical shape (see col. 1 line 58-col. 2 line 2 and 10-12) ; and

a package (cardboard box (2) in fig. 1 and 2) having a medial filler laminated to and (cardboard package (3) and see col. 1 line 50-col. 2 line 2, col. 2 line 49-col. 3 line 30) spacing apart a first

lamina (front surface of cardboard box (2)) with an outward facing surface and a second lamina (back face (2a) in fig. 1 and 2) , said filler having a pocket formed therein adapted to accommodate said predetermined shape (see col. 2 lines 32-37) and said outward facing surface of said first lamina having an image disposed thereon (see col. 1 lines 52-54) said image related to said stored user specified computer file (col. 2 lines 3-9 and lines 37-40).

Regarding claim 2, Millevolte discloses a second lamina further comprises a second outward facing surface adapted to have a postal address printed thereon (see col. 1 lines 54-57 and col. 2 lines 40-42).

Regarding claim 3, Millevolte discloses computer file further comprises an image file (see col. 1 lines 22-26 and col. 2 lines 37-40).

Regarding claim 4, Millevolte discloses image disposed upon said outward facing surface of said first lamina and related to said stored user specified image file further comprises an image derived from said image file (see col. 1 lines 31-41 and lines 52-54 and col. 2 lines 3-9 and 37-40).

Regarding claim 5, Millevolte discloses a stored second user specified computer file of said at least one stored user specified computer file, said second user specified computer file further comprising a video file compliant with a video standard (see col. 1 lines 22-30, the stored image is reproduced on a PC video screen. So it is compliant with a video standard).

Regarding claim 6, Millevolte discloses computer writeable storage medium further comprises a linking between said video file and said image file (see col. 1 lines 27-30 and col. 2 lines 6-8. There are two files. The first file is the image on the post card and the second one is the image on the floppy disk or CD-ROM which is to be reproduced in a PC video screen. The

image on the postcard shows what is recorded on the floppy disk or CD-ROM, hence indicates the relation or association between the two files).

Regarding claim 7, Millevolte discloses computer writeable storage medium further comprises a CD (see col. 1 lines 1-6).

Regarding claim 13, the limitations of claim 13 can be found in claim 1 above. Therefore claim 13 is analyzed and rejected for the same reason as described in claim 1 above.

Method claims 15-19 are rejected for the same reasons as described in the apparatus claims 2-6 above.

Regarding claim 21, Millevolte discloses a personalized storage medium and packaging created in accordance with the method claim 13 (see col. 2 lines 3-9).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Digital Photo & Video Maker [online] http://www.dazzle.com/products/photo_gut.html.

Regarding claim 8, Davis discloses an apparatus that creates a personalized storage medium and packaging comprising: a processor that accept still image content (see col. 8 lines 45-51) input and creates a first digital image file suitable for storing on the personalized storage medium (see fig. 1 central processing unit (4), memory (6), fig. 10 graphical image creating

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means (46), memory disk (42), housing (44), and col. 5 lines 51-53, col. 6 lines 19-21, col. 8 lines 33-41 and 52-56) and a second digital image suitable for printing an image on the packaging (see fig. 1 central processing unit (4), print medium (14), printer (12), printed output (16), fig. 4 front panel (1) and substrate (24), and col. 6 line 64-col.7 line 7); a data recorder (hard drive, compact disc or diskette. See col. 5 lines 52-54, col. 6 lines 38-41, 52-56) that stores said digital image file on the personalized storage medium; and a printer that prints said second digital image file on a first surface of the packaging (see col. 8 lines 56-63 and fig. 4 front panel (1)).

Claim 8 differs from Davis in that the claim further requires a processor that accepts still image content and video content, and video file compliant with a video standard; and a data recorder that stores said first digital image file and said video file on a personalized storage medium.

In the same field of endeavor Digital Photo & Video Maker [online] discloses creating video and still images CDs, edit the images, create photo albums, calendars, posters, greeting cards and more (see page 1). Therefore in light of the teaching in the Digital Photo & Video Maker [online], it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis by providing a video file in order to share high quality video memories with friends and family.

Regarding claim 9, Davis discloses a data processor (see fig. 1 central processing unit (4)) that accepts input (see input (10) in fig. 1) from a user suitable for printing on a second surface of the packaging (see col. 8 lines 42-51).

Regarding claim 10, Davis discloses a data processor that accepts a postal address from a user for printing on a second surface of the packaging (see col. 8 lines 42-51, col.9 line 58-col. 10 line 9 it is inherent that the user can type a postal address on the second surface of the substrate).

Regarding claim 11, Davis discloses data recorder further comprises a CD burner for storing said first image file on a CD (see col. 5 lines 44-54, it is inherent that the computer has a CD burner to store the image on the CD).

In the same field of endeavor Digital Photo & Video Maker [online] discloses creating video CDs (see page 1).

7. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of The Easy to use Solution for capturing, editing, and sharing your home videos [online] http://www.dazzle.com/products/emme_gut.html

Regarding claim 8, Davis discloses an apparatus that creates a personalized storage medium and packaging comprising: a processor that accept still image content (see col. 8 lines 45-51) input and creates a first digital image file suitable for storing on the personalized storage medium (see fig. 1 central processing unit (4), memory (6), fig. 10 graphical image creating means (46), memory disk (42), housing (44), and col. 5 lines 51-53, col. 6 lines 19-21, col. 8 lines 33-41 and 52-56) and a second digital image suitable for printing an image on the packaging (see fig. 1 central processing unit (4), print medium (14), printer (12), printed output (16), fig. 4 front panel (1) and substrate (24), and col. 6 line 64-col.7 line 7); a data recorder (hard drive, compact disc or diskette. See col. 5 lines 52-54, col. 6 lines 38-41, 52-56) that stores said digital image file on the personalized storage medium; and

a printer that prints said second digital image file on a first surface of the packaging (see col. 8 lines 56-63 and fig. 4 front panel (1)).

Claim 8 differs from Davis in that the claim further requires a processor that accepts still image content and video content, and video file compliant with a video standard; and a data recorder that stores said first digital image file and said video file on a personalized storage medium.

In the same field of endeavor The Easy to use Solution for capturing, editing, and sharing your home videos [online] discloses storing a video content to the computer to create video data CDs (see page 1). Therefore in light of the teaching in the Digital Photo & Video Maker [online], it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Davis by providing a video file in order to share high quality video memories.

Regarding claim 12, The Easy to use Solution for capturing, editing, and sharing your home videos [online] discloses an audio processor that accepts

audio content input and creates a digital audio file suitable for storing on the personalized storage medium (see page 1 and 2).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millevolte in view of Sansone (US Pat. No. 5,909,373).

Claim 14 differs from Millevolte in that the claim further requires the step of accepting payment for creating the personalized storage medium and packaging.

Although Millevolte does not teach accepting payment for creating the personalized storage medium and packaging, Millevolte does teach that the sale of the postcard is a new consideration (see col. 1 lines 13-17).

In the same field of endeavor, Sansone discloses a kiosk process module that performs transaction (see col. 36-55). Sansone further discloses the kiosk contains a currency slot (see col. 2 lines 56-64). Sansone further discloses a printer that prints the report (see col. 3 line 62-col. 4 line 3). Therefore in light of the teaching in Sansone it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millevolte by including a kiosk process module in order to create personalized storage medium and packaging.

In re page 4 of the applicant argument about claim 14, the Applicant states that “Neither of the printers are shown to print user-desired images. Even when Sansone and Millevolte are advantageously combined (assuming such combination proper), Applicant's claimed invention is not disclosed or suggested because the proposed combination does not have the filler laminated between the first and second surfaces and the proposed combination does not have a payment for the storage medium and its packaging. Therefore claim 14 has not been shown to be obvious in view of Millevolte and Sansone.

In response the examiner respectfully disagrees. It is noted that the features upon which applicant relies (i.e., to print user desired image) are not recited in the rejected claim 14. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the filter laminated between the first and second surface is recited in claim 1.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millevolte.

Regarding claim 20, although Millevolte does not specifically disclose the step of storing at least one user specified computer file further comprises the step of storing a second user specified computer file as a digital audio file, Millevolte discloses the created images are reproduced in PC video screen (see col. 1 lines 22-30). Official Notice is given that it is well known in the art to store audio and video together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millevolte by storing a digital audio file in order to include sounds for the created images.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barlett et al. (US Pat. No. 5,318,222).

Martinez et al. (US Pat. No. 5,101,973).

CD Digital card, CD Business Card CD Cutting & Shipping [online] Available:

<http://cddigitalcard.com/cdmaller.him>

DVC 11 Digital Video Creator 11 [online Available:

http://www.dazzle.com/products/vidcrz_gut.html

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.

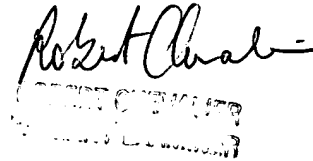
The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MEHRDAD DASTOURI can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
March 4, 2006



Robert Chahal